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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,669	03/14/2002	Joseph D. Franko SR.	20020049.ORI	3004

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EXAMINER

ZIRKER, DANIEL R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 6/23/04 and 6/25/04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-28 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-28 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner notes that on page 10 of applicant's response applicant clearly appears to admit that obviousness-type double patenting rejections in view of the claims of each of copending Application Serial Nos. 10/294,111 and 10/294,287 are particularly appropriate. Accordingly, the Examiner notes applicant's admission and his willingness to submit a terminal disclaimer(s) as needed should any of the pending claims be allowed and at which time it is expected that the terminal disclaimer(s) will be filed.

3. Claims 1-28 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More particularly, applicant's specification is again believed to be little more than a large invitation to experiment, for reasons set forth throughout the prior prosecution and as supplemented by this rejection. To somewhat partially reiterate, applicant's specification discusses "permanent adhesives" as simply adhesives based on the vague proposition that they are non-pressure sensitive adhesive in nature, and also are "tack free in the

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cured or final adhesive state". Apparently he believes that they are adhesives characterized by "relatively high ultimate adhesion" which sometimes can be removed but generally are not removable and further admits that the term "permanent adhesive" has often been misused by others in the field. Additionally, the Examiner again notes that such a vague standard with respect to the definition of a permanent adhesive is simply an invitation to experiment, and that a prospective infringer has no guidelines as to indicate what sort of adhesives would or would not read upon applicant's disclosed and also claimed genus of adhesives. With respect to applicant's remarks, his Table set forth on page 12 of his response is again noted as not found in the specification nor nowhere supported in his specification nor have any definitions from the scientific literature as to, e.g. the properties of the various adhesives been presented. Additionally, with respect to the newly presented claims, it appears that a great amount of new matter may well exist in the claims as now amended. Most notable is his use of the term "non-pressure sensitive adhesive" which is "tack free in its final state in the label" and thereby forms a "permanent" hinge. Additionally, the five claims set forth in dependent claim 2 and independent claim 21 and dependent claim 28 each appear to fall under the rule of Ex parte Grasselli et al., Board of Appeals 231 USPQ 393, affirmed CAFC 738 F. 2d 453 (Fed.

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Cir. 1984) to the effect that limitations such as "free of" a particular element are new matter in the absence of an express support. As such, the term "non" in front of each of the five adhesives set forth in the three recently referred to claims and also the claim limitation that the adhesive "is tack free in its final state in the label" and the use of "non-pressure sensitive adhesive" are each clearly believed to be equivalent to the language "free of a particular element" and thus fall under the Grasselli et al. rule. The Examiner has searched throughout applicant's specification to find whether or not there might be any sort of express support for this and related limitations, but the only recitation that appears at all relevant is at page 2, lines 27-28 where there is referred to "a permanent adhesive material which is not pressure sensitive and which thereby forms a permanent hinge", which, it is respectfully submitted, is clearly inadequate to support almost all, if not indeed all of the terms which applicant has introduced into his claims. Finally, it is further noted that applicant in his response from pages 11-14 presents various arguments in support of his utilization of these terms, but none of these terms or arguments finds clear unambiguous support in any sort of objective evidence, none of which has been presented to the Examiner at this point in the prosecution. In summary, the Examiner repeats

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that applicant's specification appears to be little more than an invitation to experiment, and also the claims are replete with new matter, as well as being based upon a non-enabling disclosure.

4. Claims 1-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum, Jr. et al., substantially for reasons of record, together with the following additional observations. More particularly, although applicant's claim amendments are believed to have removed any grounds for a holding of anticipation, the Examiner believes that the reference renders obvious the claimed genus of articles and clearly teaches, e.g. at column 3 lines 49-51 and elsewhere that although pressure sensitive adhesives can be utilized, so can "another adhesive system as known in the art". Accordingly, the Examiner believes that it is well within the ordinary skill of the art to utilize non-pressure sensitive adhesives, and since applicant claims almost every imaginable type of adhesive except for a pressure sensitive adhesive as being suitable for use in his various layered elements it is believed that whatever adhesive that was chosen would clearly read upon, or at most render obvious, the claimed genus of articles set forth in applicant's claims.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel

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Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

September 8, 2004

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300  
1700

*Daniel Zirker*